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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/653,719	09/01/2000	Alla Jurievna Krylova	JSS-0005	6607

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EXAMINER

NGUYEN, CAM N

ART UNIT	PAPER NUMBER
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1754

DATE MAILED: 08/21/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/653,719

Applicant(s)
Krylova et al.

Examiner
Cam Nguyen

Art Unit
1754

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Nov 7, 2002
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above, claim(s) 18 and 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

1. Applicants' remarks and amendments, filed on November 7, 2002, have been carefully considered. Claims 1, 8-9, & 13-17 have been amended.

Claims 1-19 remain pending in this application.

2. Applicants affirmed the election with traverse of Group I, claims 1-17, in Paper No. 5 is acknowledged.

3. This application contains claims 18-19 which drawn to an invention nonelected with traverse in Paper No. 5. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Objections

4. Claim 13 is objected to because of the following informalities:

In claim 13, line 2, "promoter metal" should be --promoter metals--.

Appropriate correction is required.

Claim Rejections - 35 USC § 112 (Second Paragraph)

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. Regarding claim 1, step (c), the proper Markush terminology is --promoter metals selected from the group consisting of rhenium, ruthenium, palladium, iron and cobalt--. See MPEP § 2173.05(h).

B. Claim 4 recites the limitation "the fluid" in line 1. There is insufficient antecedent basis for this limitation in the claim.

C. Regarding claims 10-12, line 1, "said metal" is unclear as to whether the metal of step (b)? or the promoter metal of step (c)? Thus, renders the claims unclear, vague and indefinite.

Claim Rejections - 35 USC § 102(b)/103

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 14 & 16 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kibby et al., "hereinafter Kibby", (U.S. Pat. 4,492,774).

Kibby discloses an enhanced catalyst wherein a synthetic cobalt aluminosilicate catalyst (see col. 2, ln 5-7) is added with silver, gold, or a Group VIII metal selected from platinum, palladium, ruthenium, and iridium, preferably ruthenium, onto the surface of the catalyst (see col. 3, ln 16-19). The claim is met by the teaching of the reference since ruthenium is taught to be suitable among the listed metals.

Recitation of product-by-process limitations in the claims is noted. While the product of the reference is not made by the same process as being claimed, the product made is the same and contains the same catalytic components. Further, it has been held that "even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method or production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even the prior art product was made by a different process." See *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

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9. Claims 15 & 17 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Mauldin et al., "hereinafter Mauldin", (U.S. Pat. 4,992,406).

Mauldin discloses a catalyst having promoted activity with cobalt and rhenium added (see col. 5, ln 18- col. 6, ln 65).

Recitation of product-by-process limitations in the claims is noted. While the product of the reference is not made by the same process as being claimed, the product made is the same and contains the same catalytic components. See *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Response to Amendment/Arguments

10. Applicants' amendment/response filed on November 7, 2003 has been fully considered, but deemed not persuasive in view of the new ground of rejections above and the following reasons.

Applicants' urging regarding the Kibby reference and the Mauldin reference for not teaching the same process of preparing a catalyst as claimed in the instant claims 14-17 is noted. However, applicants' urging is not found persuasive because the instant claims 14-17 are drawn to a catalyst not a process of preparing a catalyst. Further, it has been held that "even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its

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method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even the prior art product was made by a different process.” See *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Allowable Subject Matter

11. Claims 1-13 are not being rejected under the art rejection because they contain allowable subject matter. The following is a statement of reasons for allowable subject matter.

The prior art does not disclose or fairly suggest a process of forming a dispersed active metal (DAM) catalyst requiring step (a) in combination with step b) thru step (e) (as recited in claim 1).

Applicants’ urging is found persuasive and there is no motivation to combine the teachings of the references together.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion


13. Claims 1-19 are pending. Claims 1-17 are rejected. Claims 18-19 remain withdrawn due to nonelected (distinct) invention. No claims are allowed.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Cam Nguyen, whose telephone number is (703) 305-3923. The examiner can normally be reached on M-F from 8:30 am. to 6:00 pm, with alternative Monday off.

The appropriate fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310 (before finals) and (703) 872-9311 (after-final).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Nguyen/cnn *can*
August 19, 2003


Cam Nguyen
Patent Examiner
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